
Remarks

Claims 1 to 43 are pending.

1. Examiner has objected to Claims 17-24, 26, 33 and 35 because of informalities. These informalities have been addressed.

2. Examiner has rejected Claims 1-13, 37 and 39-42 under 35 U.S.C 101 alleging that the claimed invention is directed to non-statutory subject material because the invention as claimed does not meet the so called “technological arts” test or analysis. The examiner finds the separate “technological arts” test in In re Musgrave, 431 F2d. 882, 167 USPQ 280 (CCPA1970); In re Toma, 575 F2d.872, 197 USPQ 852 CCPA1978) and Ex Parte Bowman, 61 USPQ2d 1669 (Brd. Pa. App. & Int. 2001) (non-precedential). The Board of Patent Appeals and Interferences emphatically rejected the “technological arts” test in the recent case of Ex Parte Lundgren, Appeal No. 2003-2088. The majority of the Board stated: “Our determination is that there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under § 101. We decline create one. Therefore it is evident that the examiner’s rejection can not be maintained. (Id at 7). The same holds true in this application.

Examiner’s rejection of claims 1-13, 37 and 39-42 set out in Paragraph 9 of his Office Action are based on the premise they are an attempt to patent an abstract idea not a tangible “process”, and are therefore non statutory subject matter. In Musgrave, the court reversed a rejection under 35U.S.C. §101 that the claims under review therein were non-statutory because it disagreed with the Board that “these claims are directed to non-statutory processes merely because all or some of the steps can be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think.” Musgrave 431 F2d at 893, 167 USPQ 289.

After so holding the court went on to observe: “[a]ll that is necessary, in our view, to make a sequence of operational steps a statutory ‘process’ with in 35U.S.C.§101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of ‘useful arts.’ Const. Art.1, sec. 8.”

35 U.S.C. §101 does not require use of a machine, or article of manufacture in furtherance of a process, it merely requires the process to be new and useful or the improvement of an already existing process be new and useful. Nor does it allow the granting or withholding a patent to be based on any level of use of technology which the claimed invention might use to advance the underlying process.

3. Examiner as rejected to Claims 34, 37, 38 AND 42 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claims claims 34, 37, 38 and 42 to overcome the 35 U.S.C. 112, second paragraph objection by conforming the language of the claims to prior antecedent bases. In summary, Applicants submit that the Examiner’s rejections of Claims 34, 37, 38 under 35 U.S.C. 112, second paragraph have been overcome, and that the objections should be withdrawn.

4. Examiner as rejected to Claims 1,2,9, 12, 14-24,28-30, 35,36, 42 and 43 under 35 U.S.C. 102 (e) as anticipated by Shapiro (Us 6,714,944 B1). Applicant’s method claims differ from those taught in Shapiro in several respects. Shapiro recites the use of a digital storage medium as the basis for all of its claims. Applicant’s Claim 1 is not limited thereto. Applicant’s Claim 28 allows the identity verification applicant to include or exclude identity verification data from the personal profile. Applicant’s Claim 29 allows the identity verification applicant to include or selectively exclude identity verification data from the

personal profile concerning the applicant's credit data, any criminal convictions, employment, gender, drivers license possession, verification of residence address, marital status, or add personal comments. Claim 33 teaches a direct access between the applicant and the third party/invitee which limits the time for which the applicant's profile may be viewed. Claim 37 adds the notation "declined" to individual items in the template viewable by third parties to signify items which the identity verification applicant has chosen to exclude from their profile. None of these features and improvements are anticipated or taught by Shapiro.

5. Examiner has rejected to Claims 3-8, 13,17,25,26,34 and 37 as being unpatentable over Shapiro. Examiner concedes in Paragraphs 38,41,44,47,50,53 of the office action that there are differences in back ground information. Specifically, ¶38- that the applicant's background information can comprise name, (preferred and legal.), date of birth, sex, social security number, citizenship, acknowledgement of any criminal convictions; ¶41 that the applicant's display can be modified to display all or some of the following data: name, (preferred and legal.), date of birth, sex, social security number, citizenship, acknowledgement of any criminal convictions; ¶44 that an independent entity verifies applicant's felony convictions, misdemeanor convictions, employment, credit score, sex offender classification, gender, drivers license possession, address, city of residence, stat of residence, marital status and legal name; ¶47- data base for sorting data regarding applicant's credit data, any criminal convictions, employment gender, drivers license possession, verification of residence address and marital status; ¶ 50- Claim 34 has been amended to delete claim applying the PersonaCheck service mark.

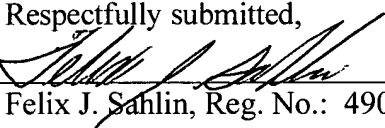
The root of the Examiner's rejections of all of these claims is the premise that the background verification method/system would be performed regardless of the type of user background information was (sic) collected/verified. Examiner next posits as to each claim that this

descriptive data will not distinguish the claimed invention from the prior art in terms of patentability. *In re Gulack* and 703 F2d 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983) and *In re Lowry*, 32 F3d 1579, 32 USPQ 401, 404 (Fed Cir. 1994) are cited as the precedents for this position. Examiner's reliance on both cases is misplaced. In *Gulack*, the Federal Circuit stated that what is required is the existence of *differences* between the claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. *Gulack* at 404. In effect, it is the expression of the data which makes it the method or arrangement patentable. Shapiro neither discloses or suggests any of the features of claims 3-8, 13,17,25,26,34 and 37. *Lowry* teaches that it is the structure and nature of the data as a whole which is patentable. It further teaches the differences reside not in the content of each individual data point but its position in the data matrix.

6. Rejection of Claims 33, and 39-41 under 35USC 103 (a) as unpatentable over Shapiro in view of Austin et al. Claim 33 limits the time to which third parties have access to the identity verification applicant's profile. Rosen limits access to a single view. Applicants specifically disputes Examiner's rejection of Claim 38 based on a presumption contained in paragraph 70 and elsewhere that the employment of secure servers would have been obvious to one of ordinary skill in the art at the time that the invention was made. Shapiro et al are presumed to be of ordinary skill in the art and did not include such a feature.

In view of the above, it is submitted that the application is in condition for allowance. Allowance of elected claims at an early date is solicited.

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